

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/670,884 09/27/00 TIRADO

J D/A0571

EXAMINER

PM82/0828

JOHN E BECK
XEROX CORPORATION
XEROX SQUARE 20A
ROCHESTER NY 14644

SCHILAK, D
ART UNIT

PAPER NUMBER

3653
DATE MAILED:

08/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.

09/670,884

Applicant(s)

Tirado et al.

Examiner

Daniel K Schlak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 22 and 23 is/are rejected.
- 7) ☒ Claim(s) 10-21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Objections

¹⁰⁻²¹
Claims ~~1-21~~ are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 10 depends from claim 1. Claim 1 is an article comprising a disk and a fastener. Claim 10, and all claims depending therefrom, recite all kinds of limitations for a classifier wheel, but these claims do not further limit the "article", which is the scope of the independent claim. If Applicant desires claim coverage for a classifier wheel in addition to coverage for a disk, Applicant is advised to draft an independent claim directed to a classifier wheel and pay the fees associated therewith. These claims have subsequently not been treated on their merits.

Claim Rejections - 35 USC § 112

The rejections under 35 U.S.C. 112 2nd paragraph, from the first Office action, have been withdrawn by the examiner for reasons.

The first reason is the amendment which has removed the antecedent basis issue. The second reason is that recent decisions by the Board of Appeals have indicated that Examiners are now to give patentable weight to recitations which claim a combination which lies outside the scope of the preamble. It has been the board's

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opinion that Applicants, by claiming an element, thereby incorporate said element into the claim, regardless of the scope of the preamble.

Therefore, the recitation in the independent claims "attach the disk to a particle outlet opening of a classifier wheel", although only indicating the intended use of the disk, is no longer a matter of indefiniteness in the claims.

Further, the claims now indicate that Applicant is seeking claims which cover a disk for attachment to the outlet of a classifier wheel. The claims are definite.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is no support for a disk which has a size of up to 10,000 centimeters. This is a preposterous range of sizes, completely unenabled, although somewhat entertaining to think about. If the circular opening were 10,000 centimeters in diameter, the entire apparatus itself would be the size of a small town.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-9, 22, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by either of references 2,754,967 or 2,367,906.

Applicant has been completely nonresponsive in these rejections which were posed by the Examiner in the prior action.

Considering that the references clearly teach classifier wheel devices in which the particle outlet opening areas are adjusted by replaceable disks which are available having different sized holes, the Examiner is unsure why the rejections are traversed without the claims being amended. Any person of reasonable intelligence, with or without experience in the art, can see that the disks (48 in 2,754,967 and 47 in 2,367,906) are *exactly* what is being claimed in claims 1-9 and 22. Applicant has failed to respond to these rejections, and is advised to at least review the rejections and art used prior to further responses.

Clearly the disk is replaceable, as is explicitly taught in '967, column 6, lines 35 and 36. Clearly the inside is thinner near the particle outlet and thinner near the periphery of the disk. These segments are each thicker than the particles and thinner than any of the surrounding walls of the device. (Note that applicant, in claim 2, has provided no reference point for "thicker" and "thinner". One reading this claim cannot assume that "thicker" is intended to be a reference of comparison to the article which is "thinner"). The lip or rim of 2,754,967 is reference number 47. The lip or rim of 2,367,906 is 32.

Conclusion

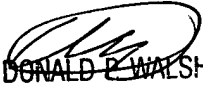
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel K Schlak whose telephone number is 703-305-0885. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 306 - 4173. The fax phone numbers for the organization where this application or proceeding is assigned are 703-306-4195 for regular communications and 703-306-4195 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308 - 1113.

dks
August 26, 2001


DONALD P. WALSH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600